

**REMARKS/ARGUMENTS**

In this response, all rejections are respectfully traversed. As such, no claims have been amended.

**35 U.S.C. §103 Rejection, Netbank**

Claims 1, 2, 4-10, 13, 14 and 16 have been rejected under 35U.S.C. §103 (a) as being unpatentable over Netbank in view of Althoff et al.. This rejection is respectfully traversed.

As set forth in Applicant's previous amendment, claim 1, recites, *inter alia*, "storing...the privacy preference onto the payment instrument," and claim 13 recites, *inter alia*, "providing...a payment instrument having stored thereon a privacy preference." As recognized in the office action, these limitations are not disclosed in the Netbank reference. As described in Applicant's previous response, the Althoff patent also fails to teach such limitations.

In response to Applicant's previous amendment, the Office Action makes reference to paragraphs [0051] through [0053] of Althoff to teach that a smart card can store and manage certain secure information. More specifically, the Office Action recites that, "Althoff et al. teaches, for a system and method for protecting consumer personal data, that the method comprises: storing at least some of the personal data in the privacy preference onto the payment instrument, a smart card (51) with a memory or a magnetic stripe (paragraphs [0051] through [0053])."

Applicant respectfully disagrees that Althoff teaches the storage of a privacy preference onto the payment instrument. Rather, paragraphs [0051] through [0053] of the Althoff patent teach "a smart card (51), of a type that is well known in the art." The smart card is used to store information such as a registered personal security code that is used to verify that the person using the card (51) during a particular transaction is the true card holder (see paragraph [0052]). The smart card may also include information to pre-populate a checkout form such as the consumer's name, address, telephone number, email address, credit card number and

expiration date, billing address, shipping address, shipping preferences, and the like (see paragraph [0053]). None of these items are a privacy preference. Thus, nowhere in the Althoff patent is there any teaching of storing a person's privacy information onto the payment instrument. Hence, even if the teachings of Netbank and Althoff are combined they still fail to teach the limitations of storing a privacy preference on the presentation instrument. As such, these references when combined clearly fail to present *prima facie* case of obviousness. As such, it is respectfully requested that the §103 rejection of claims 1, 2, 4-10, 13, 14 and 16 be withdrawn.

Claims 1 and 3 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Netbank in view of Pollin. This rejection is respectfully traversed. As previously described, the Netbank reference fails to disclose the storing of a privacy preference onto a payment instrument. The Office Action agrees and relies on the Pollin patent to teach a method that comprises "utilizing the check as the payment instrument; and storing the secure information onto the printed MICR on the check."

Applicant's respectfully disagree with this interpretation of the Pollin patent. Nowhere in the Pollin patent is there any teaching or suggestion of storing privacy preferences on the MICR line of a check. At best, the Pollin patent teaches the following with respect to MICR printing: "when all verification is complete, the system generates a paper bank draft payable to the creditor, using a MICR-ink so that the draft can be processed in the banking system like an ordinary check." Column 6, lines 19-22. Hence, nowhere in the Pollin Patent is there any teaching or suggestion of storing a privacy preference on a negotiable instrument, let alone on the MICR line of a check. As such, the Examiner's assertion is misplaced. Hence, for at least this reason claims 1 and 3 are distinguishable over Netbank and Pollin and it is respectfully requested that this rejection be withdrawn.

Claim 15 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Netbank and Althoff and further in view of Pollin.

As previously described, none of these three references teach or suggest the placement of a privacy preference on to a negotiable instrument. Hence, claim 15 is

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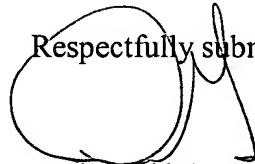
distinguishable for at least the reasons previously described, and it is respectfully requested that the §103 rejection of claim 15 be withdrawn and the application be allowed to issue.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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